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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) BONN-060	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on August 8, 2005 Signature <u>James C. Lydon</u> Typed or printed name <u>James C. Lydon</u>		Application Number 09/936,077	Filed December 3, 2001
		First Named Inventor Bruno COLIN et al.	
		Art Unit 1743	Examiner Ludlow, Jan M.
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>James C. Lydon</u> Signature James C. Lydon Typed or printed name	
<input type="checkbox"/>	applicant/inventor.		
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number <u>30,082</u>	<u>703-838-0445</u> Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>August 8, 2005</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1460, Alexandria, VA 22313-1460.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Bruno COLIN et al.

Serial Number: 09/936,077

Group Art Unit: 1743

Filing Date: December 3, 2001

Examiner: Ludlow, Jan M.

For: APPARATUS ENABLING LIQUID TRANSFER BY CAPILLARY ACTION THEREIN

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

August 8, 2005

Sir:

Applicants request a panel of examiners review the legal and factual basis of the rejection in this application pursuant to the Commissioner's Notice dated July 12, 2005. In this regard, the application has been finally rejected, no after-final or proposed amendments accompany this Request, and a Notice of Appeal is being filed concurrently herewith.

STATUS OF CLAIMS

Claims 1-8 and 10-12 are canceled.

Claims 9 and 13-16 are pending, and each of these claims is being appealed.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants' invention is an apparatus in which compartments are defined by a partition, creating a space in which at least one

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PATENT

liquid sample can be displaced in a directed and independent fashion. When two liquid samples are present, they can both be independently displaced and brought together so that they can react with one another.

Independent claim 9 recites an apparatus comprising at least one planar surface wherein at least two compartments are made and defined by a partition, the compartments creating a space which makes it possible to displace at least two liquid samples independently of one another, the compartments comprising at least two different types of grooves:

- at least one deep groove capable of partitioning samples from one another, the depth and the width of the deep groove in relation to the partition being such that capillary action of a sample is not enabled, and

- at least two shallow grooves, each of the shallow grooves being capable of receiving one of the samples, respectively, the depth of shallow grooves in relation to the partition being such that capillary action of the sample is enabled, each shallow groove being adjacent to the deep groove, along the entire length of said deep groove.

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Claim 13 depends from claim 9 and specifies a deep groove is positioned between two shallow grooves.

Claim 14 depends from claim 13, and further requires the two shallow grooves meet at one of the ends of the deep groove to create a reaction zone there, where the two liquid samples may be brought together.

Claim 15 depends from claim 14, and further requires the distance between the reaction zone and the partition is such that capillary action is enabled.

Claim 16 depends from claim 14, and further requires the distance between the reaction zone and the partition is such that capillary action is not enabled.

REJECTION TO BE REVIEWED

The sole rejection is an anticipation rejection of claims 9 and 13-16 over U.S. Patent 6,582,662 to Kellogg et al. (hereinafter "Kellogg et al.").

CLEAR ERRORS IN THE EXAMINER'S ANTICIPATION REJECTION

For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a

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person of ordinary skill in the field of the invention, Scripps Clinic & Res. Found. V. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). Yet there are at least two limitations of independent claim 9 which are not met by Kellogg et al. First, the Examiner has cited capillary junction 311, illustrated in Fig. 5 of Kellogg et al., as satisfying the "deep groove" feature of the claimed apparatus. However, capillary junction 311 is clearly not a "groove", as explained in detail in the accompanying Request for Reconsideration at page 3, line 4 to page 5, line 9.

Kellogg et al. also fails to satisfy the limitation that each shallow groove is adjacent to the deep groove along the entire length of the deep groove. The Examiner's interpretation of capillary channels 308 and 313 as "adjacent" capillary junction 311 along the entire length of capillary junction 311 is clearly erroneous, as explained in detail in the accompanying Request for Reconsideration at page 5, line 10 to page 6, line 11.

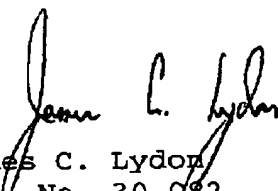
Kellogg et al. utterly fails to disclose (or suggest) a deep groove having two shallow grooves adjacent the long groove along its entire length. In particular, one of ordinary skill in this art would not consider capillary junction 311 to be a long, narrow channel, or capillary channels 308 and 313 to be next to capillary

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junction 311 for its entire length. Reconsideration and withdrawal of the anticipation rejection of claims 9 and 13-16 are earnestly requested.

Respectfully submitted,



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